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FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER ZHOU, TING	
			ART UNIT 2173	PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/806,545

Applicant(s)

FUJITA ET AL.

Examiner

Ting Zhou

Art Unit

2173

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15 and 17-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The Request for Continued Examination (RCE) filed on 29 November 2004 under 37 CFR 1.53(d) based on parent Application No. 09/806,545 is acceptable and a RCE has been established. An action on the RCE follows.

2. The amendments submitted with the filing of the RCE on 21 October 2004 have been received and entered. Claims 1-13, 15 and 17-24 as amended are pending in the application.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory and nonfunctional descriptive material. The claims disclose the layout of an image file and the limitations lack any functional relationship to the underlying prevention of unauthorized redirecting of the displayable image; an image file itself cannot prevent unauthorized redirecting of the displayable image, it is the program stored on a medium or some other instructions that causes a computer to prevent unauthorized redirecting of the displayable image when it is determined that the image file and related data are embedded together in the same image file. The examiner suggests the claims be rewritten as process claims that reflect the steps of executing the prevention of unauthorized redirecting of the displayable image, similar to the claim language format used in claim 6.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: what program or instructions cause and execute the prevention of unauthorized redirecting of the displayable image; the embedded layout of an image file alone does not prevent unauthorized redirecting of the displayable image, it is a program or some other instructions that cause a computer to prevent unauthorized redirecting of the displayable image due to the embedded layout of the image file. The examiner suggests the claims be rewritten as process claims that reflect the steps of executing the prevention of unauthorized redirecting of the displayable image, similar to the claim language format used in claim 6.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Iwamura U.S. Patent 6,807,285.

Referring to claim 1, Iwamura teaches a computer readable recording medium on which an image file is recorded (computer readable storage medium capable of storing digital data) (column 3, lines 8-16, column 17, line 57 – column 18, line 4 and Figure 11), wherein the image file includes a displayable image and related data embedded in the image file (the image file includes an image data field for storing the image data G, and related data embedded in the image file such as a digital watermark and confidential information) (column 5, lines 41-60, column 6, lines 23-31 and column 17, line 57 – column 18, line 4), the related data including at least one of identification information inherent to the image file, pointers of one or a plurality of information, an index of a menu item corresponding to the image file, and an entity of a predetermined program (embedded information such the digital watermark, key information, image name, etc. describes and identifies the image data) (column 17, line 57 – column 18, line

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4), wherein embedding of the displayable image and the related data into the same image file prevents unauthorized redirecting of the displayable image (embedding the watermark prevents illegal copies or alteration/destruction of the image) (column 1, lines 33-48, column 5, lines 41-47 and column 6, lines 23-31).

Referring to claim 2, Iwamura teaches a computer readable recording medium on which an image file is recorded (computer readable storage medium capable of storing digital data) (column 3, lines 8-16, column 17, line 57 – column 18, line 4 and Figure 11), wherein the image file includes a first area and a second area embedded in the image file, the first area configured to record data used to display an image, the second area configured to record data related to but not used to display the image (the image file is divided into a first area configured to record data used to display an image, or the image data filed storing the image data itself, and a second area configured to record data related to but not used to display the image, or the image header field, recording information such as a digital watermark, key information, image attribute information, etc.) (column 17, line 57 – column 18, line 4 and Figure 11), the related data in the second area including at least one of identification information inherent to the image file, pointers of one or a plurality of information, and an entity of a predetermined program (embedded information such the digital watermark, key information, image name, etc. describes and identifies the image data) (column 17, line 57 – column 18, line 4), wherein embedding of the displayable image and the related data in the first and second areas, respectively, in the same image file prevents unauthorized redirecting of the displayable image (embedding the watermark with the image data prevents illegal copies or alteration/destruction of the image) (column 1, lines 33-48, column 5, lines 41-47 and column 6, lines 23-31).

Referring to claim 3, Iwamura teaches a computer readable recording medium on which an image file is recorded (computer readable storage medium capable of storing digital data) (column 3, lines 8-16, column 17, line 57 – column 18, line 4 and Figure 11), wherein the image file includes a displayable image and related data embedded in an area of the image file that is ignored when data from the image file is used to display the displayable image (the image file includes an image data field for storing the image data G, and related data embedded in the image file such as a digital watermark and confidential information; the embedded watermark and image header information are ignored, or not displayed when displaying the image from the image file; when displaying the image file, only the image data itself is displayed) (column 5, lines 41-60, column 6, lines 23-31 and column 17, line 57 – column 18, line 4), the related data including at least one of identification information inherent to the image file, pointers of one or a plurality of information, an index of a menu item corresponding to the image file, and an entity of a predetermined program (information such the embedded digital watermark, key information, image name, etc. describes and identifies the image data) (column 17, line 57 – column 18, line 4), wherein embedding of the related data in the area of the image file that is ignored prevents unauthorized redirecting of the displayable image (embedding the watermark prevents illegal copies or alteration/destruction of the image) (column 1, lines 33-48, column 5, lines 41-47 and column 6, lines 23-31).

Referring to claim 4, Iwamura teaches a computer readable recording medium on which an image file is recorded (computer readable storage medium capable of storing digital data) (column 3, lines 8-16, column 17, line 57 – column 18, line 4 and Figure 11), wherein a pointer to information used to display an image and an instruction for handling the information are

embedded in the image file (embedding a pointer to information used to display an image, or an offset to a storage location of the image data, and an instruction for handling the information, such as key information, a digital watermark or confidential information) (column 5, lines 15-61, column 6, lines 23-31 and column 17, line 57 – column 18, line 4 and Figure 11), the pointer and the instruction configured to be dealt as one pair so that one pair or a plurality of pairs of the pointer and the instruction is recorded (storing the watermark and image data together, embedded in one file) (column 5, lines 15-28, column 6, lines 23-31 and column 17, line 57 – column 18, line 4 and Figure 11) wherein embedding of the instruction for handling the information in the image file prevents unauthorized redirecting of the displayable image (embedding the watermark with the image data prevents illegal copies or alteration/destruction of the image) (column 1, lines 33-48, column 5, lines 41-47 and column 6, lines 23-31).

Referring to claim 5, Iwamura teaches recording means on which an image file is recorded, input means for inputting at least one of pointers of one or a plurality of information, an index for a menu item corresponding to the image file, and identification information of an entity of a predetermined program (inputting, or supplying identification information for the image file such as a digital watermark) (column 5, lines 15-28), and information processing means for recording at least one of the pointer of the information input from the input means, the index of the menu items corresponding to the image file, and the entity of the program corresponding to the identification information (storing, or embedding identification information for the image file such as a digital watermark, to be extracted by the extracting apparatus) (column 5, lines 53-61 and Figures 1-3).

Referring to claim 6, Iwamura teaches a medium on which an image file creation program is recorded which causes a computer to execute the steps of: receiving image data and related data, the related data including at least one of pointers of one or plurality of information, an index for a menu item corresponding to the image file, and identification information of an entity of a predetermined program (receiving image data and related data, such as a digital watermark and confidential information for embedding with the image data) (column 5, lines 41-60, column 6, lines 23-31 and column 17, line 57 – column 18, line 4); and recording the image data and the at least one of pointers of one or a plurality of information, the index of the menu items corresponding to the image file, and the entity of the program corresponding to the identification information in the same image file (storing, or embedding image data with image related information such as header information, a digital watermark, and confidential information) (column 5, lines 53-61, column 17, line 57 – column 18, line 4 and Figure 11), wherein recording of the image data and the related data in the same image file prevents unauthorized redirecting of the image data (embedding the watermark prevents illegal copies or alteration/destruction of the image) (column 1, lines 33-48, column 5, lines 41-47 and column 6, lines 23-31).

Referring to claim 7, Iwamura teaches information processing means for reading out the image file from the recording medium in response to a request from a terminal device and returning it to the terminal device (reading out, or extracting embedded second information from digital data in order to recover the first information) (column 4, line 10-18).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8-13, 15, 17 and 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyle U.S. Patent 6,141,010 and Iwamura U.S. Patent 6,807,285.

Referring to claim 8, Hoyle teaches a medium for recording an image file processing program (the GUI module and ADM module shown in Figure 2) in order to cause a computer to execute the steps of monitoring an access to an information image file managed in a first managing area of the informational image file (the first window region displayed on the GUI comprises user-selectable items, associated with image files, or data sets) (Hoyle: column 4, lines 19-32), displaying an image based on image related information included in the information image file on a second managing area, and managing the information image file on the second managing area, when the information image file managed in the first managing area is accessed (the second program module, in response to user selection of one of the links in the first window region, can select associated information, stored as data sets, or image files, in the database, to be displayed in the second, or information display region) (Hoyle: column 4, lines 32-49), monitoring an access to an information image file managed in the second managing area of the informational image file, accessing and executing a file pointed to by the predetermined pointer or a corresponding file stored in advance on a local recording medium, when the information image file managed in the second managing area is accessed (in response to user interaction with

the computer, such as user clicking on a banner advertisement displayed in the second, or information display region, the programs, or links associated with the advertisement are initiated) (Hoyle: column 9, lines 49-59). For example, as shown in Figures 5, 5a and 7, in response to the category selected by the user from the first managing area comprising the hierarchical display of selectable categories (Hoyle: Figure 5a), corresponding banner ad 78 is displayed in the second managing area (Hoyle: Figure 5), and upon user selection of the advertising banner, the user is directed to the corresponding link associated with the banner; the information associated with each banner is stored as an image file data set in the database (each row of the banner database) (Hoyle: Figure 7). However, although Hoyle teaches storing the image file and image related information together as one data set (Hoyle: column 14, line 59 – column 15, line 6 and Figure 7), Hoyle fails to explicitly teach preventing unauthorized redirecting of the image by including the image on the first managing area and the image related information on the second managing area in the same information image file. Iwamura teaches a recording apparatus that stores image data and image related information together (Iwamura: column 17, line 58 – column 18, line 4 and Figure 11) similar to that of Hoyle. In addition, Iwamura further teaches storing the image and the image related information in the same information image file in order to prevent unauthorized redirecting of the image (embedding image related information such as a watermark or some confidential information with the digital image to protect and manage the copyright of the original image) (Iwamura: column 3, lines 16-48, column 5, lines 15-47 and column 6, lines 23-31). It would have been obvious to one of ordinary skill in the art, having the teachings of Hoyle and Iwamura before him at the time the invention was made, to modify the image file processing program for managing the image and image related information of

Hoyle to include storing the image and image related information in the same image file, taught by Iwamura. One would have been motivated to make such a combination in order to protect and manage the copyright of the image, preventing illegal copying and alteration of the contents of the image.

Referring to claim 9, Hoyle teaches an access to an information image file managed in the first managing area being a drag and drop operation for a corresponding image, as recited in column 10, lines 11-18.

Referring to claim 10, Hoyle teaches an access to an information image file managed in the first managing area being a selection operation for a menu displayed with respect to the corresponding image, as recited in column 9, lines 39-44 and further shown by reference character "70" in Figure 5.

Referring to claim 11, Hoyle teaches an access to an information image file managed in the first managing area being a drag and drop operation for a menu (drag and drop operations for adding or removing buttons on the toolbar menu) displayed with respect to a corresponding information image file, as recited in column 11, lines 21-29.

Referring to claim 12, Hoyle teaches an access to an information image file managed in the first managing area being a click operation for a corresponding image, as recited in column 9, lines 57-59 and column 15, lines 3-6.

Referring to claim 13, Hoyle teaches an access to an information image file managed in the first managing area being a drag and drop operation for a corresponding information image file, as recited in column 10, lines 11-18.

Referring to claim 15, Hoyle teaches the first managing area being a window for viewing a web page of a WWW browser, a window for viewing a body of e-mail software, a window for checking an attached file of e-mail software, a folder window for referring a file stored on a recording medium, or a window which is displayed by operating input means for an image or an image file (the first managing area displays a graphical user interface comprising a window capable of displaying links to different information sources, such as WWW pages or image files such as banners), as recited in column 4, lines 22-35.

Referring to claim 17, Hoyle teaches the first managing area and second managing area formed and managed by independent programs (the first managing area is formed and managed by the first program module, or GUI module and the second managing area is formed and managed by the second program module, or the ADM module), as recited in column 4, lines 19-50 and column 6, lines 62-65.

Referring to claim 19, Hoyle teaches a view of the first managing area and a view of the second managing area displayed simultaneously with a frame, as shown in Figures 5 and 5a, where the area for displaying ads is shown in the same window, or frame, as the GUI containing the menu item icons for manipulating the interface display.

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Referring to claim 20, Hoyle teaches when an access is made to an information image file managed in a first markup description language file which is a first managing area, a second markup description language file which is a second managing area is read out from memory means, and, after the second markup description language file is updated so that the second markup description language file manages the information image file, the second markup description language file is executed (when the user selection of a link in the first program

module is detected, the second program module is operable to select and display the informational data), as recited in column 4, lines 19-49.

Referring to claims 21-24, Hoyle teaches an information processing means for reading out the image file from the recording medium in response to a request and displaying the image file on a display device (in response to user selection of a category shown in Figure 5a, such as "Sports", "Players", etc., an associated banner advertisement image associated with the category selection will be displayed) (column 4, lines 19-49, column 5, lines 48-67 and column 9, lines 49-59).

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyle U.S. Patent 6,141,010 and Iwamura U.S. Patent 6,807,285, as applied to claims 8 and 17 above, and Shaw et al. U.S. Patent 5,809,242.

Referring to claim 18, Hoyle and Iwamura teach all of the limitations as applied to claims 8 and 17 above. However, Hoyle and Iwamura fail to explicitly teach view selection tabs for selecting one of views of a first managing area and a view of a second managing area. Shaw et al. teach an image file (banner) processing device similar to that of Hoyle and Iwamura. In addition, Shaw et al. further teach displaying view selection tabs for selecting one of views of a first managing area (first managing area tab for reading emails) and a view of a second managing area (second managing area tab for writing emails) in order to display selectively the managing area at a side of a tab selected through input means (Shaw et al.: column 16, lines 66-67 and continuing onto column 17, lines 1-19 and Figure 8). It would have been obvious to one of ordinary skill in the art, having the teachings of Hoyle, Iwamura and Shaw et al. before him at

the time the invention was made, to modify the image file processing systems of Hoyle and Iwamura to include the use of selection tabs taught by Shaw et al. It would have been advantageous to make such a combination in order to better organize the display of information shown to the user; separating information categories into groups and displaying them in separate tabs will allow the users to see all the functions and information relating to one group, without getting confused by the cluttered display of mixed information from multiple groups.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-13, 15 and 17-24 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

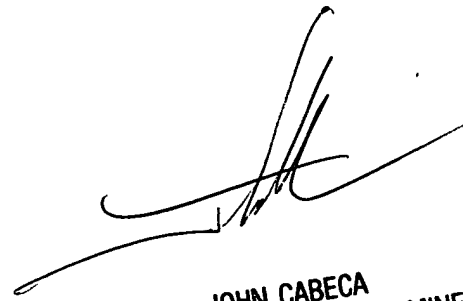
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (571) 272-4058. The examiner can normally be reached on Monday - Friday 8:30 am - 6:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached at (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-4058.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

26 January 2005



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